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OFFICE OF PETITIONS

DECISION ON PETITION

The petition considered under 37 CFR 1.183 is DISMISSED. This decision is not a final agency action. While the delay in treating the petition is sincerely regretted, it is noted that the petition was only recently brought to the attention of this office.

Petitioners seek the earlier filing date of the basis that copendency with the immediate parent case can thereby be obtained, as (1) that parent application (09/261,079) issued as U.S. patent No. 6,277,606 on August 21, 2001, and (2) petitioners were diligent, but unsuccessful over an extended period in trying to have the USPTO correct the correspondence address in the parent case, and likewise were diligent in trying to ascertain the issue date of the patent case.

STATUTE AND REGULATION

35 U.S.C. § 111(a) states:

(1) WRITTEN APPLICATION.-An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

(2) CONTENTS.-Such application shall include-

(A) a specification as prescribed by section 112 of this title;

(B) a drawing as prescribed by section 113 of this title;
and

(C) an oath by the applicant as prescribed by section 115 of this title.

(3) FEE AND OATH.-The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(4) FAILURE TO SUBMIT.-Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath was unavoidable or unintentional. **The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office** (emphasis added).

35 U.S.C. § 120 provides, in part:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application, shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application, and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

§ 1.183 *Suspension of rules.*

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in §1.17(h).

OPINION

Since the earliest date that the instant application papers (i.e., a specification containing at least one claim) were received by the USPTO is admittedly August 22, 2001, that is the earliest filing date that can properly be accorded these papers, as the filing date of an application is governed by statute. See 35 U.S.C. § 111(b)(4) ("[t]he filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office."

It is well settled that the use of "shall" in a statute is the language of command, and where the directions of a statute are mandatory, then strict compliance with the statutory terms is essential. Farrel Corp. v. U.S. Int'l Trade Comm'n, 942 F.2d 1147, 20 USPQ2d 1912 (Fed. Cir. 1991). As such the earliest filing date permitted by § 111(b)(4) is the date of receipt of the instant correspondence at the USPTO: August 22, 2001.

As to consideration of the petition under 37 CFR 1.183, that regulation, by its terms, may not be invoked to waive any requirement of the rules that is also a requirement of the patent statute. Since the requirement of 37 CFR 1.53(b) that is here sought to be waived is likewise a requirement of the applicable statute, 37 CFR 1.183 simply cannot be invoked--or properly applied-- to override that requirement of law as such is beyond the authority, much less the discretion, of the USPTO. Since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute. See A.F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977). That is, the USPTO simply lacks the authority or the discretion to relax any requirement of law. See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998)(the PTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 U.S.C. §§ 112, 120); A.F. Stoddard v. Dann, Id. Accordingly, the petition considered under 37 CFR 1.183 is dismissed.

It is is unfortunate that petitioners waited for receipt of the Issue Notification instead of filing the continuing application at the same time the issue fee was paid in the parent application. Petitioners should note that MPEP §1306.03 has long contained the following caveat: "[b]ecause the Issue Notification may be mailed less than two weeks before the application is expected to issue as a patent, applicants are advised to file any continuing application **before** receiving the Issue Notification to avoid loss of copendency" (emphasis added).

This section of the MPEP merely reflects the prior notices that members of the public and registered practitioners were given at "Patents to Issue More Quickly After Issue Fee Payment", 1220 *Off. Gaz. Pat. Office* 42 (March 9, 1999) which states, in pertinent part "[a]s part of the Patent and Trademark Office's changes in business practices to streamline its processing of patent applications, and thereby maximize patent term of patents, the PTO has established an objective to issue patents within four weeks of payment of the issue fee by July 1999 instead of the current average

of three months;" and at "Filing of Continuing Applications, Amendments, or Petitions after Payment of Issue Fee", 1221 *Off. Gaz. Pat. Office* 14 (April 6, 1999) which states, in pertinent part:

"Filing continuing applications: Since a continuing application (a continuation, divisional, or continuation-in-part) may be filed anytime before an application is patented or abandoned, applicants will often wait for the Issue Notification before filing such a continuing application. *Therefore, the PTO strongly advises applicants not to wait for receipt of an Issue Notification before filing any desired continuing application* [emphasis added].

This is because applicants will now receive the Issue Notification just shortly before the application will issue as a patent (when it may be too late to prepare and file a continuing application). Applicants are reminded that: (1) the requirement that there be copendency for an application to obtain any benefit of the filing date of the prior application is a statutory requirement (35 U.S.C. 120) which the PTO cannot waive; and (2) the patent statute contains no provisions for restoring a patented application (unlike an abandoned application) to pending status.

The PTO specifically advises practitioners to be prepared to file any desired application preferably no later than the date the issue fee is paid, to avoid issuance of the application before the continuing application is filed."

This application is being returned to the Office of Initial Patent Examination (OIPE) for further processing. Any questions related to OIPE processing should be directed to OIPE's Customer Service hotline at (703) 305-1820.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-1820.



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